

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES V. YOUNG

Appeal No. 2004-0363
Application 09/176,866

ON BRIEF

Before GARRIS, PAK and OWENS, ***Administrative Patent Judges.***

PAK, ***Administrative Patent Judge.***

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1 through 7, 9 and 15 through 20, which are all of the claims pending in the present application.

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APPEALED SUBJECT MATTER

The examiner set forth five different grounds of rejection for five different groups of claims.

According to the appellant (Brief, page 9):

With respect to the 35 [U.S.C.] [§] 102(b) rejection, Claim 1 stands alone.

With respect to the 35 [U.S.C.] [§] 103(a) rejection[s], claims of 2-7, 9, and 15-20[]are to be considered as a single group.

The various groups stand or fall separately. Within the groups, the claims stand or fall separately.

The appellant, however, argues only the limitations of claims 1 and 15 separately in the manner consistent with 37 CFR § 1.192(c)(7) and (c)(8)(2002). Therefore, for purposes of this appeal, we select one claim from each group of claims subject to a common ground of rejection, i.e., claims 1, 2, 4, 15 and 19, as representative of all claims in that group and decide the propriety of the examiner's five different rejections based on those selected representative claims. **See *In re McDaniel***, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002). Claims 1, 2, 4, 15 and 19 are reproduced below:

1. A massage apparatus for massaging a human body, comprising:

a housing;

a motor associated with said housing;

a drive cable operatively connected to said motor;

a massage head driven by said motor through said cable, said motor imparting mechanical oscillations to said massage head;

an applicator removably mounted to said massage head for transferring the mechanical oscillations to the body, said applicator head further having a cavity formed in an end surface of the applicator for permitting skin to be drawn inwardly of the cavity, the cavity being substantially the size of the end surface, and a connection tube formed in said applicator, said tube communicating with said cavity, said connection tube capable of applying at least a partial vacuum to the cavity so as to draw and stretch fibrous tissue of the human body within the cavity, said connection tube being removable with said applicator and adapted to pass contaminants from the cavity;

a vacuum pump associated with said housing; and

a connection between said vacuum pump and said applicator to impart at least a partial vacuum in the cavity of the applicator so that placement of the head on a human body results in the application of a force combination of mechanical oscillation and suction, said connection including a suction line carried externally of said drive cable, said suction line having a first end operatively connected to said vacuum pump and a second end operatively attached to said connector tube, said connection tube drawing contaminants from the cavity through said connection tube.

2. A massage apparatus of claim 1 further including a speed control associated with said housing for controlling the speed of the motor.

4. The apparatus of claim 3 further including a second vile for collecting air born containment's operatively associated in said vacuum line.

15. A therapy massage device comprising:

a housing;

a motor mounted to the housing;

a vacuum pump mounted to the housing;

a drive cable operatively connected to the motor;

a massage head operatively driven by the cable;

an applicator removably mounted to the massage head, said applicator having a concave shaped cavity formed in an end surface of it, and a connection tube attached to said applicator head in operative communication with the cavity, said connection tube capable of applying at least a partial vacuum to the cavity so as to draw and stretch fibrous tissue within substantially the entire cavity, the cavity having a size about the size of the end surface;

a vacuum line connected between the connection tube of the applicator and the vacuum pump, said vacuum line drawing contaminants from the cavity through said connection tube; and

a control system mounted to the housing which is selectively operated to provide suction and vibration to the body through the applicator head.

19. The device of claim 18 further including a second filter operatively associated with the vacuum line.

PRIOR ART REFERENCES

As evidence of unpatentability of the claimed subject matter under 35 U.S.C. § 102(b) or § 103, the examiner relies on the following prior art references:

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Rohrer	2,655,147	Oct. 13, 1953
Howerin	4,341,540	Jul. 27, 1982
Marshall et al. (Marshall)	4,469,092	Sep. 4, 1984
Holt et al (Holt)	254,957	Jul. 15, 1926
(Published British Patent Application)		

REJECTIONS

The appealed claims stand rejected as follows:

- (1) Claim 1 under 35 U.S.C. § 102(b) as anticipated by the disclosure of Holt;
- (2) Claims 2 and 3 under 35 U.S.C. § 103 as unpatentable over the disclosure of Holt;
- (3) Claims 4 and 5 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Holt and Howerin;
- (4) Claims 6, 7, 9 and 15 through 18 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Holt, Rohrer and Marshall; and
- (5) Claims 19 and 20 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Holt, Rohrer, Marshall and Howerin.

OPINION

We have carefully reviewed the claims, specification and

applied prior art references, including all of the arguments advanced by both the examiner and the appellant in support of their respective positions. This review leads us to conclude that the examiner's rejections are well founded. Accordingly, we affirm the examiner's rejections for essentially those reasons set forth in the Answer and below.

ANTICIPATION

An anticipation under Section 102 is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of a claimed invention. ***See In re Spada***, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); ***RCA Corp. v. Applied Digital Data Sys., Inc.***, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). The law of anticipation, however, does not require that the prior art reference "teach" what the present application teaches, but only requires that the claims on appeal "read on" something disclosed in the prior art reference. ***See Kalman v. Kimberly-Clark Corp.***, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), ***cert. denied***, 465 U.S. 1026 (1984).

Here, the appellant does not dispute the examiner's finding that Holt teaches a massaging device corresponding to the massage apparatus recited in claim 1, except for (1) its applicator cavity not being "substantially the size of the end surface" and not being capable of "permitting skin to be drawn inwardly" and (2) its connection tube not being "capable of applying at least a partial vacuum to the cavity so as to draw and stretch fibrous tissue of the human body within the cavity" and "adapted to pass contaminants from the cavity" See claim 1 on appeal, together with the appellant's arguments at pages 10-13 of the Brief. The dispositive question is, therefore, whether Holt teaches the claimed applicator cavity and connection tube. On this record, we answer this question in the affirmative.

We observe that Holt illustrates three applicators in Figure 4, with at least one of which having a cavity "substantially the size of the end surface." These applicators are removably mounted to the head 10 of Holt's massaging device. See page 2, lines 5-50. Although Holt does not indicate that its applicator cavity and connector tube have the claimed functional capabilities as indicated by the appellant, it is reasonable to

conclude that they are capable of performing the claimed functions since the claimed and Holt's applicator cavity and connection tube structures appear to be identical or substantially identical. **See, e.g., In re Schreiber**, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997); **In re Best**, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977). Where, as here, there is a reasonable basis to believe that Holt's applicator cavity and connection tube structures are capable of performing the claimed functions, it is incumbent upon the appellant to prove that such structures are not capable of performing the claimed functions. **Schreiber**, 128 F.3d at 1478, 44 USPQ2d at 1432. The present record, however, is devoid of such proof.

Thus, on this record, we agree with the examiner that Holt anticipates the claimed subject matter within the meaning of 35 U.S.C. § 102(b). Accordingly, we affirm the examiner's decision rejecting claim 1 under 35 U.S.C. § 102(b).

OBVIOUSNESS

The obviousness of an invention cannot be established by combining the teachings of the prior art references absent some

teaching, suggestion or incentive supporting the combination.

See ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). This does not mean that the prior art references must specifically suggest making the combination. **See B.F. Goodrich Co. V. Aircraft Braking Sys. Corp.**, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996); **In re Nilssen**, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988). Rather, the test for obviousness is what the combined teachings of the references would have suggested to those of ordinary skill in the art. **In re Young**, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); **In re Keller**, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

Here, the appellant does not dispute the examiner's finding that Holt teaches a massaging device corresponding to the massage apparatus recited in claim 15, except for (1) its applicator cavity not being "concave shaped" and not "having a size about the size of the end surface" of the applicator, (2) its connection tube not being "capable of applying at least a partial vacuum to the cavity so as to draw and stretch fibrous tissue of the human body within the cavity" and (3) its vacuum line capable

of "drawing contaminates from the cavity through said connection tube" See the Brief, pages 14-16. However, we determine that the connector tube and vacuum line described in Holt are capable of performing the claimed functional capabilities since the claimed and Holt's connection tube and vacuum line structures appear to be identical or substantially identical. **See Schreiber**, 128 F.3d at 1478, 44 USPQ2d at 1432; **Best**, 562 F.2d at 1255, 195 USPQ at 433-34. On this record, the appellant has not demonstrated that the claimed functional limitations would have rendered the structures of the claimed connection tube and vacuum line patentably different from those described in Holt.

The dispositive question is, therefore, whether the applied prior art references would have suggested employing an applicator having the claimed cavity as the applicator of the massaging device of the type described in Holt. On this record, we answer this question in the affirmative.

As found by the examiner (Answer, page 5), Holt teaches employing an applicator other than those specifically illustrated in the drawings. See also, page 2, lines 36-38. In other words, Holt teaches employing any applicator inclusive of the one

described in Rohrer, i.e., an applicator having the claimed cavity. Moreover, Rohrer teaches using the claimed applicator in a messaging device having a vacuum means useful for a human scalp, arms, limbs and other body parts. See column 1, lines 5-9 and column 2, lines 39-41. This applicator, like the applicator of Holt, can be used "to stimulate . . . body surfaces and also to clean loose . . . foreign materials from body surfaces." See column 1, lines 43-50.

Given the above teachings, we concur with the examiner that one of ordinary skill in the art would have been led to employ the applicator of Rohrer as the applicator of the massaging device of the type described in Holt, motivated by a reasonable expectation of successfully stimulating body surfaces, as well as removing foreign materials from body surfaces.

The appellant argues that Marshall does not remedy the above deficiencies of Holt. See the Brief, pages 14-15. However, the appellant does not challenge the examiner's holding that it would have been obvious to employ the claimed control system taught by Marshall in the massaging device of the type described in Holt.

Id. Thus, for the foregoing reasons, we concur with the examiner

that the applied prior art references as a whole would have rendered the subject matter defined by claims 6, 7, 9 and 15 through 18 obvious to one of ordinary skill in the art within the meaning of 35 U.S.C. § 103. Accordingly, we affirm the examiner's decision rejecting claims 6, 7, 9 and 15 through 18 under 35 U.S.C. § 103.

Further, the appellant does not dispute the examiner's holding that it would have been obvious to employ the additional features recited in claims 19 and 20 in the massaging device suggested by Holt, Rohrer and Marshall. See the Brief, page 16. Rather, the appellant argues that "they are seen as patentable under 35 U.S.C. § 103(a) over the art for the same reasons as Claim 15." *Id.* Thus, for the same reasons indicated above, we affirm the examiner's decision rejecting claims 19 and 20 under 35 U.S.C. § 103.

Finally, the appellant does not dispute the examiner's holding that it would have been obvious to employ the additional features recited in claims 2 through 5 in the massaging device of the type described in Holt. See the Brief, page 13. Rather, the appellant argues that "they are seen as patentable under 35

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U.S.C. § 103(a) over the references of record for the same reasons as Claim 1." ***Id.*** Thus, for the same reasons indicated above, we affirm the examiner's decision rejecting claims 2 through 5 under 35 U.S.C. § 103.

CONCLUSION

The decision of the examiner is affirmed.

TIMING

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

BRADLEY R. GARRIS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHUNG K. PAK)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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